

REMARKS

Claims 1 – 21 and 23 – 39 are currently pending in the application. By this amendment, claim 1 has been amended to clarify an acronym. Applicant submits that the above amendment is a clarifying amendment, and as such, should not raise any new issues requiring further search and/or consideration. Additionally, Applicant submits that no new matter is added by the above amendment. Support for the amendment may be found at least at paragraph [0004]. Reconsideration of the rejected claims in view of the above amendment and below remarks is respectfully requested.

Claim Objection

The Examiner has objected to claim 1 for containing the acronym DRM. By this amendment, Applicant has provided a description of DRM in plain text, i.e., digital rights management, as suggested by the Examiner.

Accordingly, Applicant requests the objection to claim 1 be withdrawn.

35 U.S.C. §103 Rejections

Claims 1 – 3, 5 – 11, 15 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent Publication 2003/0163784 issued to Daniel et al. (“Daniel”) in view of U. S. Patent Publication 2002/0152904 issued to Doty, Jr. (“Doty”) and U. S. Patent Publication 2002/016719 issued to Manning et al. (“Manning”). Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Daniel in view of Doty and Manning and further in view of U. S. Patent Publication 2005/0086172 issued to Stefik (“Stefik”). Claims 12 – 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Daniel in view of Doty and

Manning and further in view of U. S. Patent 6,314,517 issued to Moses et al. ("Moses"). Claims 17 – 21, 23, 25 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Daniel in view of Doty and further in view of U. S. Patent Publication 2003/0084345 issued to Bjornestad et al. ("Bjornestad"). Claim 24 was rejected under 35 U.S.C. §103(a) as being unpatentable over Daniel in view of Doty, Bjornestad and Moses. Claims 32 – 38 were rejected under 35 U.S.C. §103(a) as being unpatentable over Stefik in view of U. S. Patent Publication 2002/0169773 issued to Penrod et al. ("Penrod"). Claims 27 – 31 and 39 were rejected under 35 U.S.C. §103(a) as being unpatentable over Daniel in view of Doty. These rejections are respectfully traversed.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. See MPEP §2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.¹ Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438

¹ While the *KSR* court rejected a rigid application of the teaching, suggestion, or motivation ("TSM") test in an obviousness inquiry, the [Supreme] Court acknowledged the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" in an obviousness determination. *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1356-1357 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1731 (2007)).

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(Fed. Cir. 1991). Applicant submits that it would not have been obvious to one of ordinary skill in the art to modify the references in the manner asserted by the Examiner. Additionally, with regard to claims 4 and 32 – 38 Applicant submits that an applied reference does not constitute prior art.

Independent Claim 1 over Daniel in view of Doty and Manning

The present invention generally relates to a digital rights protection method and system. Claim 1 recites, in pertinent part:

accessing an authoring application for creating a shareable content object (SCO), the accessing being through at least one of a web based remote access and a download of the authoring application;

composing a shareable content object (SCO) representing one or more assets using the authoring application;

assigning a digital rights to the SCO to secure the one or more assets; and individually controlling access to the SCO and the one or more assets by utilizing the assigned digital rights to the SCO or the one or more assets,

wherein the download of the authoring application includes checking the client browser's version and downloading the DRM extension appropriate for the browser's version.

In addressing claim 1, the Examiner asserts that Daniel teaches the recited accessing step, at paragraph [0090] and Figures 4 and 5, and asserts that Daniel discloses the composing step, at paragraph [0094] and Figures 4 and 6. Moreover, the Examiner acknowledges that Daniel does not teach or suggest assigning digital rights to the SCO to secure the one or more assets, individually controlling access to the SCO and the one or more assets by utilizing the assigned digital rights to the SCO or the one or more assets or wherein the download of the authoring application includes checking the client browser's version and downloading the DRM extension appropriate for the browser's version.

However, the Examiner asserts that Doty discloses assigning digital rights to the SCO to secure the one or more assets, at paragraph [0169], and individually controlling access to the SCO and the one or more assets by utilizing the assigned digital rights to the SCO or the one or more assets, at paragraph [0171]. Further, the Examiner asserts that Manning discloses wherein the download of the authoring application includes checking the client browser's version and downloading the DRM extension appropriate for the browser's version, at paragraph [0018]. Moreover, the Examiner asserts that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined teaching of Daniel et al and Doty such as to check the client browser's version and download DRM extension. One would have been motivated to do so in order to provide an improved online enrollment method and system as taught by Manning et al. (paragraph [0010])."

Prima Facie Case Not Presented

Applicant respectfully submits that the Examiner has not provided a *prima facie* case of obviousness. That is, Applicant submits that, while the Examiner provided a motivation for combining Manning with the combined teaching of Daniel and Doty, Applicant submits that the Examiner has not set forth a motivation for combining Daniel and Doty. As such, the Examiner has not set forth a *prima facie* case of obviousness.

Daniel Teaches Away from a Combination with Doty

Applicant submits that one of ordinary skill in the art would not combine Daniel, Doty and Manning in the manner asserted by the Examiner. Applicant notes that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from

the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, Applicant notes that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Additionally, Applicant notes that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Daniel discloses a system and method for compiling and distributing modular electronic publishing and electronic instruction materials. More specifically, Daniel discloses at paragraph [0016] that “it is an object of the present invention to provide a system and method for simplifying collaborative compilation and publication of information” Moreover, Daniel discloses at paragraph [0018] that: (emphasis added)

. . . it is an object of the present invention to provide a system and method for compiling and publishing digital publications whereby publication informational content can be stored and later easily modified and updated for reuse in other publications by authors in a modular manner.

Thus, Applicant submits that Daniel is directed to a system in which users, e.g., authors, can utilize modularized content authored by others in order to create new publication. Moreover, Daniel discloses that an author accesses the system and creates new publications (through compiling previously stored content) using an author database and an authoring content database. The author database and the authoring content database are described at paragraphs [0081] and [0082], which Applicant has reproduced below. (emphasis added)

[0081] The author database in this preferred embodiment of the present invention is similar to the student information database in that it largely serves as a repository of information regarding authorized users who may use remote authoring and administration tools to create courses and publications as described herein. This author information can include, for example, password and user ID information, access privileges to course, publication and object libraries and the like as will become apparent after reading the description that follows.

[0082] The authoring content database contains all the libraries of objects, topical outlines of previous publications and courses, templates and skins that may be used by authors to create publications or courses according to the present invention. This authoring content database also contains the raw constituent instructional or informational content, such as written text, links, illustrations, and video and audio clips that may be included in any previously-created or in-development object stored in the network, as well as layout information (such as the arrangement of such constituent content into templates and skins as will be described below) for each object. . . .

Additionally, Daniel describes the login process to an authoring tool at paragraphs [0093] and [0094], stating that: (emphasis added)

[0093] A given author, course administrator, etc., would be identified by the central network (with which the authoring tool is communicating) according to his or her user ID and password pair as entered into login web page 500. (This user ID and password pair information being stored in the database system, thereby identifying, and defining the appropriate rights and permissions for, valid users.) In this manner, particular users of the authoring tool could be provided with access to only certain content, object, template, skin and/or publication libraries (or portions thereof) according to permission set by a duly authorized network administrator of the central network. Thus, many multiple users working on distinct projects can be supported by a single central network.

[0094] Once an author logs in by entering his or her proper unique user ID and password pair, the author begins the process of creating a modular CAI course or e-publication according to the present invention . . .

Furthermore, Daniel describes the compiling of the course or publication at paragraph [0108], stating that: (emphasis added)

... Additionally, the course or publication is compiled into a deliverable format (typically, into web pages described by HTML) and stored in the database system so as to be accessible to end user (e.g., students) as described above with respect to FIG. 3. In this manner, a deliverable version of the publication or course is ready for accessing by end users and, simultaneously, a modular version of the publication or course is still available for subsequent retrieval by the authoring tool for editing.

Additionally, Daniel discloses at paragraph [0113] that: (emphasis added)

Understandably, the object authoring and administration tool according to embodiments of the present invention can be used to modify existing courses or publications in addition to creating new courses. After logging in to the tool and loading the appropriate completed outline (containing the contents, layout, and property information, including module identification, sequencing, and skin information) for a given course or publication, the author can rearrange, replace, delete, or rewrite or reconfigure constituent objects and modules as desired or necessary.

Thus, in view of the above, Applicant submits that Daniel describes a system in which an author may provide a password and log into an authoring tool and have access to an authoring content database. However, once being provided with access (via the password) to the authoring content database containing publications, constituent objects and modules, Daniel requires that the author be able to access these documents. That is, with Daniel, access to the publications, constituent objects and modules are not individually controlled by the publications, constituent objects and modules themselves. Rather, access is granted to the publications, constituent objects and modules via an author signing into the authoring tool, so that once in the authoring tool, the author has access to the publications, constituent objects and modules.

With the above in mind, Applicant submits that the Examiner's proposed modification of Daniel, incorporating the DRM feature of Doty would render Daniel unsatisfactory for its intended purpose. That is, as described above, the intended purpose of Daniel is to provide a system and method for compiling and publishing digital publications whereby publication

informational content can be stored and later easily modified and updated for reuse in other publications by authors in a modular manner. To accomplish this, Daniel describes a system in which an authoring program, which is accessed by a password, allows the user to utilize the content database to create new works.

However, modifying Daniel such that each authored work is individually protected by DRM would preclude a user of Daniel from collaboratively authoring content using the content database upon accessing the authoring content via the password. That is, if each authored content is protected by DRM as the Examiner proposes, Applicant submits the system of Daniel would not provide authors with access to a content database upon accessing the content database via the password, as each item in the content database would additionally be individually protected with DRM.

Thus, Applicant submits that the Examiner's proposed modification of Daniel, incorporating the DRM feature of Doty would render Daniel unsatisfactory for its intended purpose. As such, Applicant submits that there is no suggestion or motivation to make the proposed modification.

Additionally, Applicant submits that modifying Daniel by incorporating the DRM feature of Doty, as the Examiner proposes, would change the principle of operation of Daniel. That is, as explained above, by individually protecting the contents of the content database with DRM, a user of the Daniel device would not be able to access the content via the password system. That is, the user would also be required to individually access each piece of content using DRM.

Thus, Applicant submits that modifying Daniel by incorporating the DRM feature of Doty, as the Examiner proposes, would change the principle of operation of Daniel. As such,

Applicant submits that the teachings of the references are not sufficient to render the claims *prima facie* obvious.

Therefore, for at least these reasons, Applicant submits that it would not have been obvious to one of ordinary skill in the art to combine Daniel, Doty and Manning in the manner asserted by the Examiner, and Daniel in view of Doty and Manning does not render the claimed invention unpatentable.

Dependent Claims 2, 3, 5 – 11, 15 and 16 over Daniel in view of Doty and Manning

Applicant submits that claims 2, 3, 5 – 11, 15 and 16 are dependent claims, depending from a distinguishable base claim. Accordingly, these claims should be in condition for allowance based upon their dependencies.

Claim 8

Additionally, Applicant submits that Daniel in view of Doty and Manning does not teach or suggest each of the features of claim 8. Claim 8 recites, in pertinent part:

. . . generating promotional material and thumbnail for use in an electronic store (eStore) to provide searching and discovery capability;
and
storing the promotional material and the SCO in an on-line catalog.

In addressing claim 8, the Examiner cites paragraph [0137] of Doty. Applicant has reproduced paragraph [0137] below, which states: (emphasis added)

FIG. 12 illustrates a screen shot of an embodiment of a sign up page 72. The sign up page 72 typically includes a personal information section including fields for name, password, license number, date of birth, social security number, promotional code, email address, credit card type, credit card number, credit card expiration date and other pertinent demographic information. The page 72 can also include a billing information section

having fields for name, address, city, state, zip code and other pertinent demographic information.

As should be understood by one of ordinary skill in the art, thumbnails are reduced-size versions of pictures, used to make it easier to scan and recognize them, serving a similar role for images as a normal text index does for words. Applicant submits that Doty merely discloses promotional codes that may be used, for example, to obtain a promotional discount. In view of the above, Applicant submits that that Doty does not teach or suggest at least the recited thumbnail.

Thus, Applicant submits that Daniel in view of Doty and Manning does not teach or suggest each of the features of claim 8, and does not render the present invention unpatentable.

Accordingly, for at least these reasons, Applicant respectfully requests that the rejection over claims 1 – 3, 5 – 11, 15 and 16 be withdrawn.

Dependent Claim 4 over Daniel in view of Doty, Manning and Stefik

Applicant submits that claim 4 is a dependent claim, depending from a distinguishable base claim. Moreover, Applicant submits that Stefik does not cure the deficiencies with regard to Daniel in view of Doty and Manning.

Thus, claim 4 should be in condition for allowance based upon its dependency. Accordingly, Applicant respectfully requests that the rejection over claim 4 be withdrawn.

Dependent Claims 12 – 14 over Daniel in view of Doty, Manning and Moses

Applicant submits that claims 12 – 14 are dependent claims, depending from a distinguishable base claim. Moreover, Applicant submits that Moses does not cure the above-noted deficiencies of Daniel in view of Doty and Manning. Applicant notes that the Examiner only cited Moses for the its purported teaching of the features of claims 12 and 14.

Thus, Applicants submit that claims 12 – 14 should be in condition for allowance based upon their dependencies.

Accordingly, Applicant respectfully requests that the rejection over claims 12 – 14 be withdrawn.

Independent Claim 17 over Daniel in view of Doty and Bjornestad

Claim 17 recites, in pertinent part:

. . . creating a package containing one or more shareable content objects (SCOs);
assigning digital rights management (DRM) to the one or more SCOs;
updating an on-line electronic store (e-Store) with the one or more SCOs;
making the one or more SCOs available for searching and downloading at a client, wherein access to the one or more SCOs is controlled by the DRM, and the one or more SCOs include one or more assets individually controllable; and
logging onto a portal server to perform any of the steps, wherein the portal server provides a common interface personalized to a user's profile and role.

In addressing claim 17, the Examiner asserts that Daniel discloses the recited creating, updating and logging steps, at paragraphs [0090], [0094] and [0114], and Figures 4 – 6. Moreover, while acknowledging that Daniel does not teach or suggest the assigning, the Examiner asserts that Doty discloses the recited assigning DRM to the one or more SCOs, at {P27070 00519142.DOC}

paragraph [0169], wherein access to the one or more SCOs is controlled by the DRM, and the one or more SCOs include one or more assets individually controllable at paragraph [0171]. Furthermore, the Examiner acknowledges that neither Daniel nor Doty teach or suggest the recited making the one or more SCOs available for searching and downloading at a client. However, the Examiner asserts that Bjornestad discloses making the one or more SCOs available for searching and downloading at a client at paragraph [0055], and that it would have been obvious to one of ordinary skill in the art to combine Bjornestad with Daniel in view of Doty. Applicant disagrees.

Prima Facie Case Not Presented

Applicant respectfully submits that the Examiner has not provided a *prima facie* case of obviousness. That is, Applicant submits that, while the Examiner provided a motivation for combining Bjornestad with the combined teaching of Daniel and Doty, Applicant submits that the Examiner has not set forth a motivation for combining Daniel and Doty. As such, the Examiner has not set forth a *prima facie* case of obviousness.

Daniel Teaches Away from a Combination with Doty

For the reasons set forth above with regard to claim 1, Applicant submits that Daniel teaches away from a combination with Doty. That is, as discussed above, Applicant submits that modifying Daniel in the manner asserted by the Examiner by incorporating the DRM of Doty would render Daniel unsatisfactory for its intended purpose and would change the principle of operation of Daniel.

Therefore, for at least these reasons, Applicant submits that it would not have been obvious to one of ordinary skill in the art to combine Daniel, Doty and Manning in the manner asserted by the Examiner, and does not render the claimed invention unpatentable.

No Teaching or Suggestion of Updating On-line Electronic Store

The Examiner asserts that Daniel discloses updating an on-line electronic store (e-Store) with the one or more SCOs at paragraph [0114]. Applicant disagrees.

Applicant has reproduced paragraph [0114] of Daniel below, which states:

To facilitate the editing of entire courses, several additional functions are provided by the authoring tool. Preferably, systems according to the present invention can enable a global search and replace utility to allow dynamic renaming of text strings within one or more e-learning objects within a course or publication. In this manner, older e-learning objects can be easily integrated with newer objects (containing newer or inconsistent terminology) without the need to individually edit each individual e-learning object.

Applicant submits that the above-cited passage of Daniel does not teach or suggest updating an on-line electronic store (e-Store) with the one or more SCOs. Rather, Applicant submits that the above passage is describing features of the authoring tool, which is used to create, compile or modify courses. As stated in Daniel, the authoring tool is operable to perform a global search and replace, to allow easier integration of older e-learning objects with newer e-learning objects without requiring individual editing of the older e-learning objects.

However, Applicant submits that this global search and replace editing of Daniel does not constitute updating an on-line electronic store (e-Store) with the one or more SCOs. That is, the global search and replace editing of Daniel occurs within the content database, which is not an on-line electronic store (e-Store).

Thus, Applicant submits that Daniel in view of Doty and Bjornestad does not teach or suggest updating an on-line electronic store (e-Store) with the one or more SCOs, and does not render the present invention unpatentable.

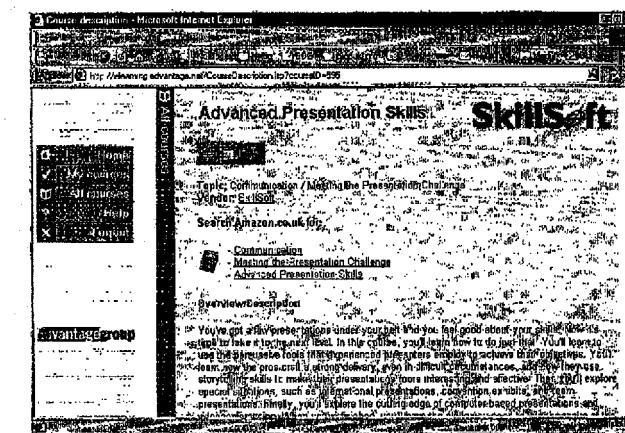
No Teaching or Suggestion of Making SCOs Available for Searching at Client

Applicant submits that Bjornestad does not teach or suggest making the one or more SCOs available for searching and downloading at a client. In addressing claim 17, the Examiner asserts that Bjornestad discloses this feature at paragraph [0055]. Applicant disagrees.

Applicant has reproduced paragraph [0055] below, which states: (emphasis added)

As shown in the screen shot of FIG. 7, a user logs into an OLMS (in this case "eLearning.EdVantage") in accordance with the invention by giving a user name and password. FIG. 8 shows how a user can have access to a range of courses, provided by different sources. FIG. 9 shows how the OLMS, using the same interface, enables a student to have access to a course--in this case a course on "Advanced Presentation Skills" provided SkillSoft (TM). From the same screen, the user can search for additional resources e.g. by looking for books through "Amazon.co.uk" (TM). As shown in FIG. 10, a student may access information on course progress, scores etc. provided by the external course provider, still using the same interface.

Additionally, Applicant has reproduced Figure 9



As shown in Figure 9, Applicant submits that Bjornestad provides a user with the ability to search Amazon.co.uk for additional information. However, Applicant submits that providing a search tool for searching a bookstore website does not constitute making the one or more SCOs available for searching and downloading at a client, as the Examiner asserts. That is, the contents of the bookstore website would not contain the SCOs. As such, the searching ability provided by Bjornestad does not make the one or more SCOs available for searching and downloading at a client.

Thus, Applicant submits that Daniel in view of Doty and Bjornestad does not teach or suggest making the one or more SCOs available for searching and downloading at a client, and does not render the present invention unpatentable.

Therefore, for at least these reasons, Daniel in view of Doty and Bjornestad does not teach or suggest each of the features of the present invention, and does not render the present invention unpatentable.

Dependent Claims 18 – 21, 23, 25 and 26 over Daniel in view of Doty and Bjornestad

Applicant submits that claims 18 – 21, 23, 25 and 26 are dependent claims, depending from a distinguishable base claim. Thus, claims 18 – 21, 23, 25 and 26 should be in condition for allowance based upon their dependencies.

Claim 23

In addressing claim 23, the Examiner asserts that Daniel discloses logging onto an electronic store (e-Store) to access the one or more SCOs, at paragraphs [0094] and [0114], and generating promotional material and supplying parameters indicating at least one of: a package

ID, at paragraph [0137], and whether each of the SCOs is encrypted, at paragraphs [0071] and [0085]. Applicant disagrees.

For the reasons set forth above, with regard to claim 17, Applicant submits that Daniel does not teach or suggest an on-line electronic store (e-Store) to access the one or more SCOs. Additionally, the Examiner asserts that Daniel discloses generating promotional material including a package ID at paragraph [0137]. However, Applicant respectfully submits that Daniel does not contain paragraph [0137]. As such, as discussed further below, Applicant submits that the Examiner has not set forth a clear action or a complete record.

Furthermore, the Examiner asserts that Daniel discloses generating promotional material and supplying parameters indicating whether each of the SCOs is encrypted, at paragraphs [0071] and [0085]. Applicant has reproduced these paragraphs below, which state: (emphasis added)

As will be readily appreciated by one of ordinary skill in the art, the sequence and grouping of objects according to the present invention can be made in many ways and still equivalently deliver appropriately leveled instruction. For example with respect to the module object depicted in FIG. 1, instead of e-learning objects 101b, 101b' and 101b" all sequencing back into e-learning object 101c through transition object 102c, after pre-test transition object 102b the student could be split off onto one of three different independent sequences. Alternatively, of course a pre-test can be included within an e-learning object using dynamic web page construction whereby the entirety of the instructional materials present in e-learning objects 101b, 101b' and 101b" are instead encoded in a single e-learning object that provides branching navigation within the object to enable the delivery of various levels of content as described above.

Web serving software running on the Web server 306a essentially creates the web pages as they are requested by obtaining the appropriate data from the database system 307 and serving that data (using the proper communication protocol such as HTTP or FTP) as may be encoded in any suitable page description or web scripting language (HTML, DHTML, XHTML, XML, JavaScript, etc.).

Applicant notes that the above-cited paragraphs are completely silent with regard to encryption. However, in addressing claim 23, the Examiner equates encryption with encoding, similar to the treatment of claim 9. Applicant submits, however, that encryption and encoding are not synonymous. That is, in cryptography, encryption is the process of transforming information (referred to as plaintext) using an algorithm (called cipher) to make it unreadable to anyone except those possessing special knowledge, usually referred to as a key. In contrast, encoding is the process of transforming information from one format into another. Moreover, while encryption is a type of encoding, Applicant submits that encoding is not a type of encryption.

Moreover, the above-cited passages of Daniel discuss a type of encoding that is not encryption. That is, Daniel teaches the encoding in any suitable page description or web scripting language (HTML, DHTML, XHTML, XML, JavaScript, etc.).

Thus, for these reasons, Applicant submits that Daniel in view of Doty and Bjornestad does not teach or suggest each of the features of claim 23, and does not render the present invention unpatentable.

Claim 25

With regard to claim 25, Applicant submits that Doty does not teach or suggest at least the thumbnail promotional material. In addressing claim 25, the Examiner asserts that Doty discloses extracting information including thumbnail promotional material from a content aggregation file at paragraph [0137]. Applicant disagrees.

Applicant has reproduced paragraph [0137] below, which states: (emphasis added)

FIG. 12 illustrates a screen shot of an embodiment of a sign up page 72. The sign up page 72 typically includes a personal information section including fields for name, password, license number, date of birth, social security number, promotional code, email address, credit card type, credit

card number, credit card expiration date and other pertinent demographic information. The page 72 can also include a billing information section having fields for name, address, city, state, zip code and other pertinent demographic information.

As should be understood by one of ordinary skill in the art, thumbnails are reduced-size versions of pictures, used to make it easier to scan and recognize them, serving a similar role for images as a normal text index does for words. In view of the above, Applicant submits that that Doty does not teach or suggest at least the thumbnail promotional material. Rather, Applicant submits that Doty merely discloses promotional codes that may be used, for example, to obtain a promotional discount. Thus, Applicant submits that Daniel in view of Doty and Bjornestad does not teach or suggest each of the features of claim 25, and does not render the present invention unpatentable.

Accordingly, for at least these reasons, Applicant respectfully requests that the rejection over claims 17 – 21, 23, 25 and 26 be withdrawn.

Dependent Claim 24 over Daniel in view of Doty, Bjornestad and Moses

Applicant submits that claim 24 is a dependent claim, depending from a distinguishable base claim. Thus, claim 24 should be in condition for allowance based upon its dependency.

Accordingly, Applicant respectfully requests that the rejection over claim 24 be withdrawn.

Independent Claim 32 over Stefik in view of Penrod

Applicant submits that Stefik is not prior art against at least independent claim 32. That is, the instant application has a filing date of December 10, 2003 and Stefik has a filing date of

April 13, 2004 and a publication date of April 21, 2005. Moreover, Applicant notes that Stefik is a continuation-in-part application of Patent No. 7,359,881 (“Stefik ‘881”), which filed February 7, 2001 and issued on April 15, 2008.

However, Applicant submits that the teachings of Stefik relied upon in rejecting at least claim 32 is not contained in Stefik ‘881. More specifically, in rejecting claim 32, the Examiner asserts that Stefik discloses an automatic validation component adapted to ensure conformance of the unprotected digital content to Shareable Content Object Reference Model (SCORM) standards and providing error messages to enable correction.

However, Applicant submits that Stefik ‘881 does not teach or suggest at least an automatic validation component adapted to ensure conformance of the unprotected digital content to Shareable Content Object Reference Model (SCORM) standards and providing error messages to enable correction. In fact, Applicant submits that Stefik ‘881 is entirely silent as to Shareable Content Object Reference Model (SCORM) standards. As such, Applicant submits that the portions of Stefik relied upon by the Examiner are not entitled to the earlier filing date of Stefik ‘881. As such, Applicant submits that Stefik cannot constitute prior art against the instant invention.

Dependent Claims 33 – 38 over Stefik in view of Penrod

Applicant submits that claims 33 – 38 are dependent claims, depending from a distinguishable base claim. Thus, claims 33 – 38 should be in condition for allowance based upon their dependencies.

Accordingly, Applicant respectfully requests that the rejection over claims 32 – 38 be withdrawn.

Independent Claims 27 and 39 over Daniel in view of Doty

Independent claim 27 recites, in pertinent part:

- ... a portal server to permit authoring of at least one shareable content object (SCO) having one or more assets;
- a digital rights management (DRM) content packager accessible via the portal server which assigns digital rights to the at least one shareable content object (SCO);
- a DRM license server which assigns license criteria to the at least one SCO and the one or more assets; and
- a content manager which stores or retrieves the at least one SCO and the one or more assets.

Independent claim 39 recites, in pertinent part:

- a first computer code to compose a shareable content object (SCO) representing one or more assets;
- a second computer code to assign a digital rights to the SCO to secure the one or more assets;
- a third computer code to individually access the SCO and the one or more assets, wherein the access to the SCO and the one or more assets is individually controlled by the assigned digital rights; and
- a fourth computer code to provide a common interface personalized to a user's profile and role to facilitate one of accessing or downloading the first computer code.

Daniel Teaches Away from a Combination with Doty

For the reasons set forth above with regard to claim 1, Applicant submits that Daniel teaches away from a combination with Doty. That is, as discussed above, Applicant submits that modifying Daniel in the manner asserted by the Examiner by incorporating the DRM of Doty would render Daniel unsatisfactory for its intended purpose and would change the principle of operation of Daniel.

Therefore, for at least these reasons, Applicant submits that it would not have been obvious to one of ordinary skill in the art to combine Daniel and Doty in the manner asserted by the Examiner, and Daniel in view of Doty does not render the claimed invention unpatentable.

Dependent Claims 28 - 31 over Daniel in view of Doty

Applicant submits that claims 28 – 31 are dependent claims, depending from a distinguishable base claim. Thus, claims 28 – 31 should be in condition for allowance based upon their dependencies.

Accordingly, for at least these reasons, Applicant respectfully requests that the rejection over claims 27 – 31 and 39 be withdrawn.

Complete Action not Provided

Applicant submits that in addressing independent claims 1 and 17, the Examiner did not set forth a proper *prima facie* case of obviousness. As such, Applicant submits that the Examiner has not set forth a complete action or a clear record.

Additionally, Applicant submits that in addressing claim 23, the Examiner cites portions of Daniel that do not exist. Specifically, the Examiner cites paragraph [0137] of Daniel. However, as discussed above, Applicant submits that Daniel does not include a paragraph [0137].

For these reasons, Applicant submits that a clear issue was not developed between the Examiner and Applicant. As such, Applicant submits that the next Office Action, which should clarify this issue, *cannot* be made final.

According to MPEP 706,

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection.

Additionally, MPEP 706.07(a) notes:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). ...

Furthermore, a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

Accordingly, Applicant respectfully submits that the Examiner may not make the next action final, as in the previous Office Action a "clear issue [was not] developed between the examiner and applicant".

CONCLUSION

In view of the foregoing amendments and remarks, Applicant submits that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-0510.

Respectfully submitted,
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